



Serial No.: 10/019,122
Applicant: BRAND, Fabien *et al.*
Reply to Office Action of April 23, 2004
Atty. Ref.: 11836.0677.PCUS00
PA-00089

REMARKS:

REMARKS REGARDING CLAIMS AMENDMENTS:

Claims 1, 10 and 11 have been amended solely in order to clarify a grammatical ambiguity—the scope of the claimed subject matter has not changed in either of these claims. Claim 5 has been amended to explicitly incorporate the limitations of both claims 4 and 1, and as 35 U.S.C. §112, ¶4 explicitly states, this amendment does not change the scope of protection sought. *See* 35 U.S.C. §112, ¶4 (“A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.”) Therefore, this amendment to claim 5 does not in any manner narrow the scope of the claimed subject matter. Claim 7 has been amended to delete the phrase “, preferably over 10°C” in response to the Examiner’s rejection under § 112. And finally, claim 12 has been amended to correct a minor typographical error.

IN RESPONSE TO THE OFFICE ACTION:

REJECTION UNDER 35 U.S.C. §112:

In response to the Examiner's rejection of claims 7, 8 and 15 under 35 U.S.C. § 112, Applicants have amended independent claim 7 to omit the phrase “, preferably over 10°C.” Applicants believe that this amendment to claim 7 addresses the Examiner's rejection and thus request the withdrawal of such rejection in the next office action. Further, as claims 8 and 15 depend from claim 7, Applicants believe that the rejection of these claims should be withdrawn as well.

REJECTION UNDER 35 U.S.C. §103:

Claims 1-4, 10, 11 and 13 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Dobson Jr., U.S. Patent No. 5,783,527 (“the Dobson reference”).

Applicants request that the Examiner reconsider and withdraw the above rejection of the claims in view of the following.

A determination under 35 U.S.C. §103 is whether the claimed invention as a whole would have been obvious to a person of ordinary skill in the art at the time the invention was made. *In re Mayne*, 104 F.3d 1339, 1341, 41 USPQ 2d 1451, 1453 (Fed. Cir. 1997). An obviousness determination is based on underlying factual inquiries including: (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the claimed invention and the prior art; and (4) objective evidence of nonobviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966), *see also Robotic Vision Sys., Inc. v. View Eng'g Inc.*, 189 F.3d 1370, 1376, 51 USPQ 2d 1948, 1953 (Fed. Cir. 1999).

In line with this standard, case law provides that “the consistent criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art.” *In re Dow Chem.*, 837 F.2d 469, 473, 5 USPQ 2d 1529, 1531 (Fed. Cir. 1988). The first requirement is that a showing of a suggestion, teaching, or

motivation to combine the prior art references is an "essential evidentiary component of an obviousness holding." *C.R. Bard, Inc. v. M3 Sys. Inc.*, 157 F.3d 1340, 1352, 48 USPQ 2d 1225, 1232 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not "evidence." *In re Dembiczak*, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1617. The second requirement is that the ultimate determination of obviousness must be based on a reasonable expectation of success. *In re O'Farrell*, 853 F.2d 894, 903-904, 7 USPQ 2d 1673, 1681 (Fed. Cir. 1988); see also *In re Longi*, 759 F.2d 887, 897, 225 USPQ 645, 651-52 (Fed. Cir. 1985). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ 2d 1780, 1783-84 (Fed. Cir. 1992).

The Examiner bears the burden of establishing a prima facie case of obviousness. *In re Deuel*, 51 F.3d 1552, 1557, 34 USPQ 2d 1210, 1214 (Fed. Cir. 1995). The burden to rebut a rejection of obviousness does not arise until a prima facie case has been established. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ 2d 1955, 1957 (Fed. Cir. 1993). Only if the burden of establishing a prima facie case is met does the burden of coming forward with rebuttal argument or evidence shift to the applicant. *In re Deuel*, 51 F.3d 1552, 1553, 34 USPQ 2d 1210, 1214 (Fed. Cir. 1995), see also *Ex parte Obukowicz*, 27 USPQ 2d 1063, 1065 (B.P.A.I. 1992).

Applicants submit that nothing in the Dobson reference teaches or suggests the subject matter recited in independent claims 1, 10 and 11. That is to say, that nothing in the cited reference discloses an aqueous drilling fluid composition that includes a hydrophobic, hydrophobically modified or oil wettable fluid loss additive and a hydrophobic, hydrophobically modified or oil wettable bridging material. Thus, both components preferentially remain oil wet and are not solubilized by the continuous phase of the drilling fluid. The use of a hydrophobic, hydrophobically modified or oil wettable fluid loss additive with a bridging material having the same characteristics results in an unexpected and surprising result as demonstrated in the Examples of Applicants specification.

In contrast, the Dobson reference teaches and discloses the use of conventional fluid loss additives and conventional bridging materials. One of skill in the art would understand and appreciate that such conventional materials often are water-wet materials to enhance the formation of the drilling fluid. The second requirement for a rejection under 35 U.S.C. § 103 is that the ultimate determination of obviousness must be based on a reasonable expectation of success. *In re O'Farrell*, 853 F.2d 894, 903-904, 7 USPQ 2d 1673, 1681 (Fed. Cir. 1988); see also *In re Longi*, 759 F.2d 887, 897, 225 USPQ 645, 651-52 (Fed. Cir. 1985). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ 2d 1780, 1783-84 (Fed. Cir. 1992). Thus, the Dobson reference must suggest the desirability of combining a fluid loss additive with a bridging material wherein both are either hydrophobic, hydrophobically modified or oil wettable in order to maintain the Examiner's obvious rejection—and this, the Dobson reference does not do.

Applicants submit that the results achieved and shown in the Examples of the specification are wholly unexpected and surprising in that one can achieve an active filtercake with the combination of a hydrophobic, hydrophobically modified or oil wettable fluid loss additive with a hydrophobic, hydrophobically modified or oil wettable bridging material. Specifically, attention is brought to the results and comparisons in Example 9 in which one fluid is formulated conventionally and the second is formulated in accordance with the presently claimed invention. Upon review it will be noted that the ability to restore the flow of fluids is dramatically increased by use of the combination of a fluid loss agent and a bridging agent wherein both are either hydrophobic, hydrophobically modified or oil wettable. Based on what is known in the art, this enhanced ability to form a filter cake that is easily removed by produced fluids is novel and not obvious. Thus, Applicants submit that the presently claimed invention is not obvious in view of the absence of teaching or suggestion to combine a hydrophobic, hydrophobically modified or oil wettable fluid loss agent with a hydrophobic, hydrophobically modified or oil wettable bridging agent in an aqueous based drilling fluid.



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The undersigned representative requests any extension of time that may be deemed necessary to further the prosecution of this application.

The undersigned representative authorizes the Commissioner to charge any additional fees under 37 C.F.R. 1.16 or 1.17 that may be required, or credit any overpayment, to Deposit Account No. 01-2508, referencing Order No. 11836.0677.PCUS00.

In order to facilitate the resolution of any issues or questions presented by this paper, the Examiner should directly contact the undersigned by phone to further the discussion.

Respectfully submitted,

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Date: July 7, 2004